UNITED STATES PATENT AND TRADEMARK OFFICE

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10/771,653	02/03/2004	Christopher W. Brumme	MS1-1822US	3526

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LEE & HAYES, PLLC
601 W. RIVERSIDE AVENUE
SUITE 1400
SPOKANE, WA 99201

EXAMINER
GEE, JASON KAI YIN

ART UNIT	PAPER NUMBER
2434	

NOTIFICATION DATE	DELIVERY MODE
12/03/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

lhptoms@leehayes.com

PTOL-90A (Rev. 04/07)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 October 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16 and 49-58* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *47* is/are allowed.

6)☒ Claim(s) *1-16 and 49-58* is/are rejected.

7)☒ Claim(s) *48* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *03 February 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   This action is response to communication: RCE filed 10/26/2009.

2.   Claims 1-16 and 47-58 are current pending in this application. Claims 49-58 are

new.

3.   No new IDS has been received.

4.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on

10/26/2009 has been entered.

Response to Arguments

5.   Applicant's arguments filed 09/24/2009 with respect to the art rejections and the

amendments have been fully considered and are persuasive. The 103 rejections have

been withdrawn.

Claim Rejections - 35 USC § 112

6.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

7.   Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

8.   As per claims 1-16, the claim limitations uses the phrase "means for", but is modified by some structure, material, or acts recited in the claim. It is unclear whether the recited structure, material, or acts are sufficient for performing the claimed function which would preclude application of 35 U.S.C. 112, sixth paragraph.

As per claims 1-16, in independent claim 1, the claim limitation recites "virtual machine means, instantiated in managed code to execute with a runtime loader, for executing...". The means for executing the assemblies seems to be instantiated in managed code. It is unclear whether the managed code is sufficient for performing the claimed function which would preclude application of 35 U.S.C. 112, sixth paragraph.

As per claims 1-16, in independent In claim 1, the claim limitation recites "means for making a call for access by the first assembly." The means for making a call seems to be modified and performed by the first assembly. It is unclear whether first assembly is sufficient for performing the claimed function which would preclude application of 35 U.S.C. 112, sixth paragraph.

As per claims 3, 7, 14, 15, and 16, the claim limitation in claim 3 recites "execution engine means ... for executing" and "means, in the native code portion, for providing". The means for executing seems to be modified and performed by the execution engine. It is unclear whether the execution engine is sufficient for performing the claimed function which would preclude application of 35 U.S.C. 112, sixth paragraph. Further, the means for providing seems to be modified by the native code.

It is unclear whether native code is sufficient for performing the claimed function which would preclude application of 35 U.S.C. 112, sixth paragraph.

As per claim 7, the claim recites "means for loading the native code with a CLR loader". The means for executing seems to be modified and performed by the CLR loader. It is unclear whether the CLR loader is sufficient for performing the claimed function which would preclude application of 35 U.S.C. 112, sixth paragraph.

Also, as per claim 7, the claim recites "means for executing… wherein the first assembly accesses the second assembly". The means for executing seems to be modified and performed by either the first or second assemblies. It is unclear whether the first or second assemblies are sufficient for performing the claimed function which would preclude application of 35 U.S.C. 112, sixth paragraph.

As per claim 14, the claim recites "wherein the execution engine means … comprises a compiler". The execution engine means for executing seems to be modified or performed by a compiler. It is unclear whether the compiler is sufficient for performing the claimed function which would preclude application of 35 U.S.C. 112, sixth paragraph.

As per claim 15, the claim recites "wherein the execution engine means ... comprises: a CLR loader". The execution engine means for executing seems to be modified or performed by a CLR loader. It is unclear whether the CLR loader is sufficient for performing the claimed function which would preclude application of 35 U.S.C. 112, sixth paragraph.

As per claim 16, the claim recites "means, in the native code portion, for forming a response". The means for forming a response seems to be modified or performed by the native code portion. It is unclear whether native code portion is sufficient for performing the claimed function which would preclude application of 35 U.S.C. 112, sixth paragraph.

Because of these issues, the specific means for performing the method steps will be ignored in the examination of the claims.

If applicant wishes to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant is required to amend the claim so that the phrase "means for" is clearly not modified by sufficient structure, material, or acts for performing the claimed function.

If applicant does not wish to have the claim limitation treated under 35 U.S.C. 112 sixth paragraph, applicant is required to amend the claim so that it will clearly not be a means (or step) plus function limitation (e.g., deleting the phrase "means for").

9.   As per claims 1-16, claim element "means for intercepting the call" and "means for determining, at runtime, access privileges" found in claim 1 is a means plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to clearly link or associate the disclosed structure, material, or acts to the claimed function such that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function. As seen in the applicant's specifications, these methods seem to be performed by a component in the server 202 pictured in

Figure 2. However, it is unclear what element in the server is performing these method steps.

As per claim 4, claim element "means for preventing the access of the first assembly" is a means plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to clearly link or associate the disclosed structure, material, or acts to the claimed function such that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function. As seen in the applicant's specifications, these methods seem to be performed by a component in the server 202 pictured in Figure 2. However, it is unclear what element in the server is performing these method steps.

As per claim 5, claim element "means for preventing the access of the first assembly to the second assembly" is a means plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to clearly link or associate the disclosed structure, material, or acts to the claimed function such that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function. As seen in the applicant's specifications, these methods seem to be performed by a component in the server 202 pictured in Figure 2. However, it is unclear what element in the server is performing these method steps.

As per claim 6, claim element "means for preventing the access of the first assembly to the second assembly" is a means plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to clearly link or associate the disclosed structure, material, or acts to the claimed function such that one

of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function. As seen in the applicant's specifications, these methods seem to be performed by a component in the server 202 pictured in Figure 2. However, it is unclear what element in the server is performing these method steps.

As per claim 7, claim element "means for permitting the access of the first assembly to the second assembly" is a means plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to clearly link or associate the disclosed structure, material, or acts to the claimed function such that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function. As seen in the applicant's specifications, these methods seem to be performed by a component in the server 202 pictured in Figure 2. However, it is unclear what element in the server is performing these method steps.

As per claims 8-9, claim element "means for permitting the access" found in claim 8 is a means plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to clearly link or associate the disclosed structure, material, or acts to the claimed function such that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function. As seen in the applicant's specifications, these methods seem to be performed by a component in the server 202 pictured in Figure 2. However, it is unclear what element in the server is performing these method steps.

As per claim 10-12, claim element "verifying means… for determining" and "means … for: permitting the means for compiling to compile … and delaying the means

for determining" found in claim 10 are means plus function limitations that invoke 35

U.S.C. 112, sixth paragraph. However, the written description fails to clearly link or

associate the disclosed structure, material, or acts to the claimed function such that one

of ordinary skill in the art would recognize what structure, material, or acts perform the

claimed function. As seen in the applicant's specifications, these methods seem to be

performed by a component in the server 202 pictured in Figure 2. However, it is unclear

what element in the server is performing these method steps.

As per claim 16, claim element "means for returning the response" is a means

plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the

written description fails to clearly link or associate the disclosed structure, material, or

acts to the claimed function such that one of ordinary skill in the art would recognize

what structure, material, or acts perform the claimed function. As seen in the

applicant's specifications, these methods seem to be performed by a component in the

server 202 pictured in Figure 2. However, it is unclear what element in the server is

performing these method steps.

Because of these issues, the specific means for performing the method steps will

be ignored in the examination of the claims.

Applicant is required to: a) amend the claim so that the claim limitation will no

longer be a means plus function limitation under 35 U.S.C. 112, sixth paragraph; or b)

amend the written description of the specification such that it clearly links or associates

the corresponding structure, material, or acts to the claimed function without introducing

any new matter (35 U.S.C. 132(a)); or c) state on the record where the corresponding

structure, material, or acts are set forth in the written description of the specification that

performs the claimed function. For more information, see 37 CFR 1.75(d) and MPEP

2181 and 608.01(o).

Claim Rejections - 35 USC § 101

10.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

11.   Claims 49-57 are rejected under 35 U.S.C. 101 based on Supreme Court

precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be

tied to a particular machine or (2) transform underlying subject matter (such as an

article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385

CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S.

584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v.

Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process

would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory

process, the claim should positively recite the particular machine to which it is tied, for

example by identifying the apparatus that accomplishes the method steps, or positively

recite the subject matter that is being transformed, for example by identifying the

material that is being changed to a different state.

Here, applicant's method steps are not tied to a particular machine and do not

perform a transformation. Although the applicant has included in the preamble that the

method is implemented by a computing device, this is not enough to overcome the

rejection as this is merely mentioned in the preamble and not identified in any of the

method steps. Thus, the claims are non-statutory.

The mere recitation of the machine in the preamble with an absence of a

machine in the body of the claim fails to make the claim statutory under 35 USC 101.

Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.

12.   Claim 58 is rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter.

As per claim 58, the claim recites "one or more computer readable medium

having stored thereon". However, the applicant's specification (reciting paragraphs from

publication 2005/0172133) states that computer readable mediums may include

communications media (paragraph 55). In paragraph 57, the specification cites that

communication media includes modulated signals such as carrier waves. Transmission

media is not one of the defined statutory categories, and thus, claim 58 is rejected

under 101 as being directed toward non-statutory subject matter.

Claim Objections

13.   Claims 48 and 50-57 are objected to because of the following informalities:

As per claim 48, the claim recites "the apparatus as defined in Claim 47." The

"apparatus" should be changed to the "server".

As per claims 50-57, the claims recite "A method as recited". The claims should

be changed to "The method as recited".

Appropriate correction is required.

Allowable Subject Matter

14.   Claim 47 is allowed.

The following is a statement of reasons for the indication of allowable subject

matter: Please see the reasons submitted in the previous Office Action on 07/24/2009.

Claim 48 will be allowed when the applicants amend the claim to overcome the

claim objections found above.

15.   Claims 1-16 and 49-58 would be allowable if rewritten or amended to overcome

the rejection(s) under 35 U.S.C. 112, 2nd paragraph and 35 U.S.C. 101 rejections set

forth in this Office action.

The following is a statement of reasons for the indication of allowable subject

matter: The applicants' amended claims with the accompanying arguments filed

09/24/2009 have overcome the prior art of record.

Conclusion

16.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to www. whose telephone number is (571)272-6431. The

examiner can normally be reached on M-F, 7:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Kambiz Zand can be reached on (571) 272-38113811. The fax phone

number for the organization where this application or proceeding is assigned is 571-

273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

/Jason Gee/
Patent Examiner
Technology Center 2400
11/30/2009